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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION N |
|-----------------|-------------|---------------------------|---------------------|----------------|
| 10/605,608 | 10/13/2003 | Mathew Frederick Heinecke | | 2607 |

34817 7590 11/01/2004

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| EXAMINER |
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BLAU, STEPHEN LUTHER

| ART UNIT | PAPER NUMBER |
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3711

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,608

Applicant(s)HEINECKE, MATHEW
FREDERICK**Examiner**

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 4-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 15 September 2004.

Claim Objections

2. Claim 1 is objected to because of the following informalities: It is longer than one sentence. In lines 5 and 8 there are periods. There should only be one period in a claim (See article 608.01(m) in the Manual of Patenting Examining Procedures). Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the top end" in line 3.

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Claim 4 recites the limitation "the top of the slit" in line 2 and "the top closed half" in line 4. There is insufficient antecedent basis for these limitations in the claims. A top end, a top of a slit and a top closed half all were not previously disclosed. Only "one end" and "the other end". The examiner recommends replacing the word "the" with the word -- a -- before each of these features to remove these rejections.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Bucher.

Bucher discloses an abrasive material forming a grip cover in tubular form with a closed end (19) and an open end (21), an open slit which extends from the opening to half the distance and more of the entire cover (Fig. 2) and a tag of material attached to the closed end (fig. 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bucher in view of Eckstein.

Bucher lacks a cover having an additional circular flap of material attached to the top end. Eckstein discloses a cover having an additional circular flap of material attached to the top end (Fig. 4, Ref. Nos. 32, 34). In view of the patent of Eckstein it would have been obvious to modify the cover of Bucher to have a cover having an additional circular flap of material attached to the top end in order to make the ends more strong due to hitting, resting and carrying the weight of the cover against the butt end of a club.

9. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Bird.

Perry discloses a cover for a bat which follows the outer profile of a bat handle with a slit opening not along the entire length of the cover but extending from the opening of the cover to half the distance of the entire cover and more (Fig. 7) and a material of rubber (Col. 5, Lns. 3-15). Perry discloses a slit being about 80% the length of the shaft with the closed half being about 20 % the length of the shaft. Clearly an artisan skilled in the art in forming a cover which is simple to make would have selected a suitable length for a slit in which the slit being only 50 % the length of the cover is included.

Perry lacks a for a golf club grip tapered only from a top of a slit opening to the bottom edges of the cover and a cover having the same width along a top closed half of the cover.

Bird discloses a bat in the form of a golf club having a cylindrical section and a tapered section below the cylindrical section (Fig. 1). In view of the patent of Bird it would have been obvious to modify the cover of Perry to be used for a golf club grip with the cover being tapered only in the bottom half with the same width along a top closed half of the cover in order to provide protection from rain for a golf club grip and in order to provide protection to a golf club with more than just the grip with the club's outer profile having a cylindrical section and a tapered section below the cylindrical section.

It would have been obvious to modify the cover of Perry to have which the slit being only 50 % the length of the cover in order to minimize the amount of zipper material needed to from a cover.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bucher in view of Gaffney.

Bucher lacks hook and loop type fastening attaching the slip opening bottom corners.

Gaffney discloses a cover for a head where the cover is secured by hook and loop type fastening attaching a slit opening bottom corners (Fig. 9). In view of the patent of Gaffney it would have been obvious to modify the cover of Bucher to have

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hook and loop type fastening attaching the slip opening bottom corners in order to utilize the advantages of this type of fastener (i.e. easier to attach than a zipper).

Conclusion

11. Enclosure (1) discloses how to make changes to your application. Enclosure (2) discloses how to place a response in the mail and the date of mailing would be used to consider if a response is received on time. These rules can be found online at <http://www.uspto.gov/web/offices/pac/mpep/index.html>

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 28 October 2004


STEPHEN BLAU
PRIMARY EXAMINER